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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/288,757 04/08/99 HOROWITZ

F 991057

EXAMINER

TM02/1215

MAX SHAFTAL  
FACTOR AND SHAFTAL  
100 W MONROE STREET  
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RECEIVED

ART UNIT

PAPER NUMBER

2166

DATE MAILED:

12/15/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/288,757

Applicant(s)

HOROWITZ ET AL.

Examiner

Leslie K. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

***Detailed Action***

1. Claims 1-23 have been examined and are pending in the application.

***Drawings***

2. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-3, 5, 7-9, 12, 13, 16, 19 and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by Spurgeon in U.S. Pat. No. 5,890,129.

As per claim 1, Spurgeon discloses a system for determining eligibility by a dental care provider for determining plan design by a dental care provider and for recording utilization of benefits by a dental care provider for a participant comprising:

- at least one computer, each such at least one computer having at least one data storage means, at least one input means, and at least one output means, the at least one computer having participant data stored on the data storage means pertaining to a participant (FIG. 1; FIG. 2; col. 3, lines 18-65; col. 8, lines 39-41);

- means associated with the at least one computer for determining eligibility of the participant (col. 9, lines 5-19); and
- means associated with the at least one computer for recording utilization of benefits by the dental care provider (col. 9, line 36 – col. 10, line 18).

As per claim 2, Spurgeon discloses a system for determining eligibility and for recording utilization of benefits by a dental care provider as addressed above. Spurgeon further discloses that the at least one computer comprises a plurality of computers being linked to define a network (FIG. 1).

As per claim 3, Spurgeon discloses a system for determining eligibility and for recording utilization of benefits by a dental care provider as addressed above. Spurgeon further discloses that the plurality of computers is linked by way of the World Wide Web (FIG. 1).

As per claim 5, Spurgeon discloses a system for determining eligibility and for recording utilization of benefits by a dental care provider as addressed above. Spurgeon further discloses that the participant identifier comprises at least one of the group consisting of: social security number, last name first name, carrier and date of birth (FIG. 5 – FIG. 8).

As per claim 7, Spurgeon discloses a system for determining eligibility and for recording utilization of benefits by a dental care provider as addressed above. Spurgeon further discloses that the benefit utilization recording means comprises means for creating a utilization record (col. 9, line 36 – col. 10, line 18).

As per claim 8, Spurgeon discloses a system for determining eligibility and for recording utilization of benefits by a dental care provider as addressed above. Spurgeon further discloses

that the benefit utilization recording means comprises means for accessing at least one created utilization record (col. 9, lines 36-57).

As per claim 9, Spurgeon discloses a system for determining eligibility and for recording utilization of benefits by a dental care provider as addressed above. Spurgeon further discloses that the utilization record includes an identification of the dental care provider, an identification of the participant, and the identification of the procedure necessitated by the participant (FIG. 5 – FIG. 9).

As per claim 12, Spurgeon discloses a system for determining eligibility and for recording utilization of benefits by a dental care provider as addressed above. Spurgeon further discloses means for updating the participant data stored on data storage means of the at least one computer of the system (col. 9, lines 5-19).

As per claim 13, Spurgeon discloses a method for providing information to dental care providers regarding a participant comprising the steps of:

- determining eligibility of the participant comprising the steps of:
  - inputting an identifier data pertaining to at least one participant as input (col. 3, lines 42-47);
  - searching for the identifier data in said participant data of a data storage means (col. 9, lines 5-19);
  - providing output in the form of data pertaining to the eligibility of the at least one participant with respect to at least one procedure necessitated by the at least one participant (col. 9, lines 5-19 and FIG. 7);

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- recording the utilization of benefits by way of a procedure by the dental care provider comprising the steps of:
  - inputting an identifier data pertaining to at least one participant as input (FIG. 9);
  - and
  - inputting a performed procedure data (FIG. 9).

As per claim 16, Spurgeon discloses a method for providing information to dental care providers regarding a participant as addressed above. Spurgeon further discloses that the step of inputting an identifier comprises the step of inputting at least one of a social security number, a last name, a first name and a date of birth (FIG. 5 – FIG. 8).

As per claim 19, Spurgeon discloses a method of establishing a network for the administration of coverage to a dental care provider comprising the steps of:

- providing a plurality of computers (FIG. 1 and FIG. 2);
- linking the computers to form a network (FIG. 1 and FIG. 2);
- storing data pertaining to a participant and to a coverage plan pertaining to the participant (FIG. 1 and FIG. 2); and
- providing access to the data of the participant from at least one of the plurality of computers, to in turn, facilitate at least one of:
  - determining the eligibility of the participant for a particular procedure (FIG. 7 and FIG. 9); and
  - recording the utilization of participant benefits by the dental care provider to form utilization records (FIG. 7 and FIG. 9).

As per claim 21, Spurgeon discloses a method of establishing a network for the administration of coverage to a dental care provider as addressed above. Spurgeon further discloses that the step of linking computers comprises the step of linking the computers by way of the World Wide Web (FIG. 1).

As per claim 23, Spurgeon discloses a method of establishing a network for the administration of coverage to a dental care provider as addressed above. Spurgeon further discloses that the step of providing access further includes the step of providing access to facilitate access to completed utilization records (FIG. 2; FIG. 3; FIG. 4; and col. 9, lines 36-57).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10, 11, 14, 15, 20, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon in U.S. Pat. No. 5,890,129.

As per claim 10, Spurgeon discloses a system for determining eligibility and for recording utilization of benefits by a dental care provider as addressed above. Spurgeon does not specifically disclose means for selecting the operation of one of the verification means and the utilization recordation means. The Examiner takes Official Notice and asserts that it is well known for computer applications to have means to select from various operations (menus, command codes, etc.). It would have been obvious to one of ordinary skill in the art at the time

the invention was made to incorporate this well-known teaching into the invention of Spurgeon. The invention of Spurgeon is enhanced since the provider gains more control over the functions of the computer application when providing service for the subscriber.

As per claim 11, Spurgeon discloses a system for determining eligibility and for recording utilization of benefits by a dental care provider as addressed above. Spurgeon does not disclose means for permitting only a select group of predetermined operators to utilize the system. The Examiner takes Official Notice and asserts that it is well known to limit the access to sensitive data on a computerized health care system to authorized personnel only. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the well-known teaching into the invention of Spurgeon. The invention of Spurgeon is enhanced since participant anxiety over unauthorized access to private records is quelled.

As per claim 14, Spurgeon discloses a method for providing information to dental care providers regarding a participant as addressed above. Spurgeon disclose that the method further comprises the step of accessing the inputted performed procedure data (col. 9, lines 36-57) but does not disclose that the step is performed in real time. The Examiner notes that the invention of Spurgeon is networked to the Internet. The Examiner takes Official Notice and asserts that it is well known to use the Internet to access data in real time. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate this well-known teaching into the invention of Spurgeon in order to allow access to inputted performed procedure data in real time. The invention of Spurgeon is thus enhanced since time required to complete billing/claiming transactions is reduced.



As per claim 15, Spurgeon discloses a method for providing information to dental care providers regarding a participant as addressed above. Spurgeon discloses that the method further comprises the step of updating at least a portion of the data pertaining to the eligibility of the at least one participant (col. 9, lines 5-19) but does not disclose that the step of providing output of such data occurs in real time. The Examiner notes that the invention of Spurgeon is networked to the Internet. The Examiner takes Official Notice and asserts that it is well known to use the Internet to access data in real time. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate this well-known teaching into the invention of Spurgeon in order to allow updating of participant data in real time.

As per claim 20, Spurgeon discloses a method of establishing a network for the administration of coverage to a dental care provider as addressed above. Spurgeon does disclose the step of updating data but does not disclose that the updating of data is done in real time. The Examiner notes that the invention of Spurgeon is networked to the Internet. The Examiner takes Official Notice and asserts that it is well known to use the Internet to access data in real time. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate this well-known teaching into the invention of Spurgeon in order to allow updating of participant data in real time.

As per claim 22, Spurgeon discloses a method of establishing a network for the administration of coverage to a dental care provider as addressed above. Spurgeon does not disclose the step of requiring a login prior to providing access to the data of the participant, to, in turn, maintain the security of the data. The Examiner takes Official Notice and asserts that it is well known to limit the access to sensitive data on a computerized health care system to

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authorized personnel only. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the well-known teaching into the invention of Spurgeon. The invention of Spurgeon is enhanced since participant anxiety over unauthorized access to private records is quelled.

7. Claims 4, 6, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon in U.S. Pat. No. 5,890,129 as applied to claims 1 and 13 above, and further in view of Moore et al. in U.S. Pat. No. 5,930,759.

As per claim 4, Spurgeon discloses a system for determining eligibility and for recording utilization of benefits by a dental care provider as addressed above. Spurgeon further discloses that the eligibility means comprises:

- means for inputting a particular identifier (FIG. 5 – FIG. 9);
- means for searching the participant data stored in the at least one data storage means for the participant's identifier (col. 9, lines 5-19);
- means for providing the participant stored data pertaining to the participant identifier to the output means of the at least one computer, to, in turn provide data as to the eligibility of a participant for a particular procedure (col. 9, lines 5-19).

Spurgeon does not teach that the eligibility-determining means comprises means for inputting a particular procedure necessitated by a participant. Moore et al. disclose a step for inputting a particular procedure necessitated by a participant in order to determine eligibility (FIG. 10C). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Moore et al. into the invention of Spurgeon. The invention of

Spurgeon is enhanced since billing and claiming is more accurate by the provider upon obtaining specific eligibility details.

As per claim 6, Spurgeon discloses a system for determining eligibility and for recording utilization of benefits by a dental care provider as addressed above. Spurgeon does not disclose that the means for inputting a particular procedure necessitated by a participant comprises means for inputting at least a procedure code, a tooth identification, and a positional identification as applicable to the procedure. Moore et al. disclose means for inputting a particular procedure necessitated by a participant comprising means for inputting at least a procedure code, a tooth identification, and a positional identification as applicable to the procedure (FIG. 10A, FIG. 10B, FIG. 10C, and FIG. 10F). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Moore et al. into the invention of Spurgeon. The invention of Spurgeon is enhanced since billing and claiming is more accurate by the provider upon obtaining specific procedural details.

As per claim 17, Spurgeon discloses a method for providing information to dental care providers regarding a participant as addressed above. Spurgeon does not disclose that the step of inputting data pertaining to a procedure comprises the step of inputting at least one procedure code pertaining to a desired procedure. Moore et al. disclose the step of inputting at least one procedure code pertaining to a desired procedure (FIG. 10F). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Moore et al. into the invention of Spurgeon. The invention of Spurgeon is enhanced since billing and claiming is more accurate by the provider upon obtaining specific procedural details.

As per claim 18, Spurgeon discloses a method for providing information to dental care providers regarding a participant as addressed above. Spurgeon does not disclose that the step of inputting data pertaining to a procedure comprises steps of:

- inputting at least one procedure code pertaining to a desired dental procedure;
- inputting an identification of the tooth undergoing the desired dental procedure;
- inputting the identification of the location of the tooth undergoing the desired dental procedure.

Moore et al. disclose the step of inputting data pertaining to a procedure comprising the steps of:

- inputting at least one procedure code pertaining to a desired dental procedure (FIG. 10F);
- inputting an identification of the tooth undergoing the desired dental procedure (FIG. 10A);
- inputting the identification of the location of the tooth undergoing the desired dental procedure (FIG. 10A).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Moore et al. into the invention of Spurgeon. The invention of Spurgeon is enhanced since billing and claiming is more accurate by the provider upon obtaining specific procedural details.

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


- Doyle, Jr. et al. teach an insurance administration system with means to allow an employer to directly communicate employee status data to centralized data storage means.
- Sackler et al. teach a health insurance management system.
- Cummings, Jr. teach an all care health management system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie K. Nguyen whose telephone number is 703-306-5540. The examiner can normally be reached on Monday-Friday, 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-9051 for regular communications and 703-308-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Leslie K. Nguyen  
December 11, 2000

  
**TARIQ R. HAFIZ**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**